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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,441	02/08/2001	Masahiko Maeda	Q63016	4617

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EXAMINER	
ZACHARIA, RAMSEY E	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/762,441	MAEDA ET AL.
	Examiner	Art Unit
	Ramsey Zacharia	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-9 and 11-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 7-9 11-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1-5, 7-9, and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh et al. (U.S. Patent 5,229,461) in view of Dessaint et al. (U.S. Patent 4,295,976).

Saitoh et al. teach a coating composition comprising a vinylidene fluoride copolymer which yields a film having excellent weatherability and stain resistance (column 1, lines 54-60). The copolymer comprises units that may be tetrafluoroethylene or chlorotrifluoroethylene (see formula II where X is fluorine or chlorine) and units having a hydroxyl functional group (formula III) (column 2, lines 17-47). The composition further comprises a curing agent, such as an isocyanate, an amino resin, or an acid anhydride, that is reactive with the hydroxyl groups in the copolymer (column 9, lines 7-29). The coating may be applied directed to the substrate or over a primer coating, such as an acrylic coating (column 11, lines 1-11).

Regarding the stain resistance limitations in claims 1 and 2, the cracking resistance limitations in claims 3 and 4, and the hydroxyl value limitation of claim 9, these are taken to material properties of the coating composition. Since the coating composition of Saitoh et al. appears to be the same as that of the instant invention (especially since page 7, lines 17-19 of the instant specification cites the composition of JP-A-4-28707 as a suitable curable fluorine-

containing resin and U.S. Patent 5,229,461 is an English language equivalent of JP-A-4-28707 as shown by Derwent abstract 1991-347997).

Regarding the limitations of claim 5, while Saitoh et al. is silent with respect to the weight of the coating, the coating weight of a protective coating is a known to affect the degree of protection (e.g. stain resistance and weatherability). As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the weight of the coating, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2nd 272, 205 USPQ 215 (CCPA 1980).

Saitoh et al. do not teach applying the composition to leather, however, the composition is taught as being applied on substrates such as metal, wood, concrete, plastic, and the like (column 11, lines 5-8).

Dessaint et al. disclose that materials such as metals, plastics, wood materials, concrete, and leather are considered equivalent substrates for fluorinated anti-staining coatings (column 1, lines 5-11).

Dessaint et al. shows that for anti-staining fluorinated coatings metal, wood, concrete, plastic, and leather are equivalent structure substrates. Therefore, because these substrates were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a leather substrate for the metal, wood, concrete, plastic, or the like material used as the substrate by Saitoh et al.

Therefore the invention of claims 1-5, 7-9, and 11-19 would have been obvious to one of ordinary skill in the art at the time the inventions were made.

Response to Arguments

3. Applicant's arguments filed 26 November 2003 have been fully considered but they are not persuasive.

The applicants argue that the disclosure of Dessaint et al. as to the equivalency of substrates for fluorinated anti-stain coatings is limited to copolymers that are the reaction product of a polyfluorinated vinyl monomer and a thioglycolic ester. The applicants argue that extending such a teaching to fluorinated anti-stain coatings in general is improper, particularly since Dessaint et al. illustrates that a fluorinated copolymer that is not reacted with a thioglycolic ester provides poor soil release properties (as illustrated in Example 1 of Dessaint et al.).

This is not persuasive for the following reasons. Dessaint et al. teach that fluorinated derivatives are known as being used to treat a wide range of substrates to render them hydrophobic and oleophobic, i.e. stain resistant (column 1, lines 12-16). The particular invention of Dessaint et al. is directed towards improving the ability of such stain resistant substrates to be washed (column 1, lines 17-26). The soil release property reported in Example 1 is not the same as stain resistance. Rather, Dessaint et al. teach that stain resistance is a function of the oleophobic and hydrophobic characteristics (see column 1, lines 12-16), which are similar or identical when comparing the fluorinated polymer with thioglycolic ester and the fluorinated polymer without thioglycolic ester. The soil release property reported is not a measure of stain resistance, but rather a measure of the ability to clean the substrate after it has been forcibly stained.

Moreover, rather than teaching away from using a fluorinated polymer such as that of French Patent 2,175,332 in the same applications (and therefore applied to the same substrates) as that of their fluorinated polymer, Dessaint et al. explicitly teach that the polymer of French Patent 2,175,332 may be used in combination with their thioglycolic ester containing fluorinated polymer (see column 8, lines 31-34).

Conclusion

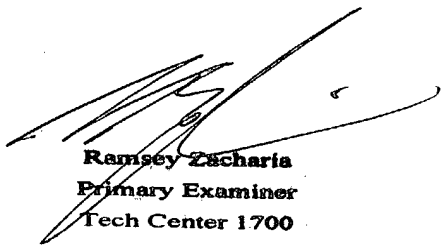
4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsey Zacharia
Primary Examiner
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